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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/999,604 12/26/1996 PAUL W. DENT 027540-688 4093

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PO BOX 37428
RALEIGH, NC 27627

EXAMINER

LUTHER, WILLIAM A

ART UNIT

PAPER NUMBER

2664

DATE MAILED: 07/01/2002

34

Please find below and/or attached an Office communication concerning this application or proceeding.

24

Office Action Summary

Application No.

08/999,604

Applicant(s)

DENT, PAUL W.

Examiner

William A. Luther

Art Unit

2664

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-29,33,43,46,48 and 50 is/are allowed.
- 6) ☒ Claim(s) 30-32,34-42,44,45,47,49 and 51-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 29.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2664

BACKGROUND

This communication (instant file wrapper paper no. i.e., #34) is issued subsequent to the issuance of a Notice Regarding Power of Attorney that was issued on June 27, 2002 to Burns Doane Swecker & Mathis LLP stating that future correspondence will be mailed to the new address of record (no paper no. assigned). The June 27 Notice was issued in response to the Revocation of Power of Attorney that was filed by applicant on June 4, 2002 (#33). The June 4 Revocation was filed subsequent to the letter, that was issued by the PTO on May 2, 2002, stating that the [April 8, 2002] Amendment has been determined compliant and entered (#32). The May 2 letter was issued subsequent to the Notice of Non-Compliant Amendment which was issued on April 18, 2002 (#31). The April 18 Notice was issued in response to the Amendment which was filed on April 8, 2002 (#30). On April 8, 2002, an information disclosure statement was also filed (#29). In addition, applicant filed a Request for Continued Examination (RCE) on April 8, 2002 (#28). The April 8 RCE was filed in response to the Office Action that was issued on February 12, 2002 (#27). The February 12 Office Action was issued in response to the Request for Reconsideration that was filed on November 19, 2001 (#26). The November 19 Request was filed in response to the Office Action that was issued on August 28, 2001 (#25). The August 28 Office Action was issued in response to the communication which was filed on June 6, 2001 (#24), and its related two-month extension of time under 37 C.F.R. 1.136 (rule 136) (#23). The June 6, 2001, communication was filed in reply to the Office action that was issued on March 13, 2001 (#22). The March 13, 2001, Office action was issued in response to the

Art Unit: 2664

communication which was filed on February 12, 2001 (#21). The February 12, 2001, communication was filed concurrent with a notice of appeal (#20) and a 2-month extension of time under rule 136 (#19). The February 12, 2001, communications were filed in reply to the Office action which was issued on September 12, 2000 (#18). The September 12, 2000, Office action was issued subsequent to the June 22, 2000, filing of the communication titled "Change of Address/Power of Attorney" (#17). Also, the September 12, 2000, Office action was issued in response to the communication which was filed on June 8, 2000 (#16). The June 8, 2000, communication was filed in reply to the notice which was issued on May 9, 2000 (#15). The May 9, 2000, notice was issued in response to the communication that was filed on February 24, 2000 (#14). The February 24, 2000, communication was filed in reply to the Office action which was issued on November 24, 1999 (#13). The November 24, 1999, Office action was issued subsequent to an information disclosure (#12) filed on August 30, 1999, and in response to an amendment (#11) which was also filed on August 30, 1999, concurrent with its rule 136 one month extension of time (#10). The August 30, 1999, amendment was filed in reply to the Office action which was issued on April 28, 1999 (#9). The April 28, 1999, Office action was issued in response to the amendment which was filed on February 4, 1999 (#8), which was filed concurrent with the rule 136 three month extension of time (#7). The February 4, 1999, Amendment was filed subsequent to the "letter" which was issued on August 5, 1998 (#6). The August 5, 1998 "letter" informed the applicant that applicant's "response to the office action mailed July 30, 1998 . . . [had] not been received . . ." (capitalization omitted). The August 5,

Art Unit: 2664

1998, "letter" was issued in response to the "status letter" which was filed on July 27, 1998 (#5). The "status letter" was apparently filed before and entered into the file wrapper after the July 30, 1998, issuance of the first Office action (#4) on the merits of this instant reissue application. The July 30, 1998, Office action was issued subsequent to the filing of the "statement under [rule] 3.73(b) and submission of documents showing name change" (capitalization omitted) which was filed on March 19, 1998 (#3). The statement under rule 3.73(b) was filed in reply to the issuance of the February 27, 1998, notice (#2) to the applicant to file certain missing parts of the instant reissue application. The February 27, 1998, notice was issued in response to the filing of the instant reissue application which was filed on December 26, 1996 (#1) under 35 U.S.C. 151 (section 151). The instant application is therefore subject to those related regulations including 37 C.F.R. 1.171 through 1.179. The instant reissue application is a reissue examination of U.S. Patent 5,377,183 ('183), which was issued on December 27, 1994. Patent '183 was issued from U.S. Patent Application 08/226,470 (Appl. '470), which was filed on April 11, 1994. Application '470, was a continuation application from its parent U.S. Patent Application 07/868,335 (Appl. '335) which was filed on April 13, 1992.

Appl. '470 file history:

The most recent paper was filed on April 1, 1997 (paper no. 22, i.e., #22), is a "status inquiry" which states "[p]lease advise, in writing, as to the current status of [Appl. '470]." The April 1, 1997, "status inquiry" was filed subsequent to the December 27, 1994, issuance of U.S. Patent '183 (#21). Patent '183 was issued subsequent to the filing of formal drawings on

Art Unit: 2664

September 13, 1994 (#20), and also subsequent to the notice of allowance which was issued on June 27, 1994 (#19). The June 27, 1994, notice of allowance was issued subsequent to the information disclosure which was filed on April 11, 1994 (#18), as well as the preliminary amendments "E" (#17) and "D" (#16) which were also filed on April 11, 1994. The June 27, notice of allowance was issued in response to the filing of Appl. '470, on April 11, 1994. It appears that the application '470 purports priority benefit to its parent application '335 under section 120.

Appl. '335 file history:

The applicant was issued a notice of abandonment on May 26, 1994 (#15). The May 26, 1994, notice was issued subsequent to the notice of appeal which was filed by the applicant on February 9, 1994 (#14). The February 9, 1994, notice of appeal was filed concurrently with a rule 136 one month extension of time (#13). The February 9, 1994, notice of appeal was filed in reply to the advisory action which was issued on February 4, 1994 (#12). The February 4, 1994, action was issued in response to the amendment which was filed under 37 C.F.R. 1.116 on January 12, 1994 (#11). The January 12, 1994, amendment was currently filed with a rule 136 two month extension of time (#10), and in reply to the Office action which was issued on August 9, 1993 (#9). The August 3, 1993, Office action was issued in response to the amendment which was filed on May 19, 1993 (#8), and subsequent to the information disclosure which was filed on February 23, 1993 (#7). The May 19, 1993, amendment was filed in reply to the Office action which was issued on February 19, 1993 (#6). The February 19, 1993, Office

Art Unit: 2664

action was issued subsequent to the filing of an information disclosure on July 10, 1992 (#5), a preliminary amendment which was also filed on July 10, 1992 (#4), and a declaration which was filed on June 10, 1992 (#3). The June 10, 1992, declaration was filed in reply to the related notice (which required the filing of such a declaration) which was issued on May 11, 1992 (#2). The May 11, 1992, notice was issued in response to the filing of Appl. '335, on April 13, 1992.

The applicant seeks a reissue of the U.S. Patent '183 under section 151, which was filed on April 11, 1994. It also appears that the applicant claims priority benefit under 35 U.S.C. 120 (section 120) to Appl. '335, and thus apparently desires an effective filing date of April 13, 1992. The instant reissue application was filed within two years of the issuance of U.S. Patent '183, and thus the applicant is not barred from reissued claims which are broader in scope than those claims of the issued U.S. Patent '183, with the exception of limitations related to "surrender and recapture" preclusion.

By preponderance of the evidence in view of the above related prosecution history in the manner provided for under In re Oetiker 977 F.2d 1442 (Fed. Cir. 1992) , the examiner cannot conclude that the pending reissue claims satisfy the requirements of 35 U.S.C. 151 in that it appears that there are specific limitations that cannot be omitted from the reissue claims under "surrender and recapture" preclusion.

Response to the Amendment (#30) and RCE (#28)

Instant claims are broadened on some aspects and narrowed in other aspects. In the prosecution of the patent (U.S. Patent Appl. 07/868,334) by the After Final Amendment filed on

Art Unit: 2664

January 10, 1994, the applicant amended the claims adding certain subject matter that applicant describe in section (d), #26, at 6. This subject matter is hereby rejected under section 251 as being surrendered subject matter (below). Applicant argues that certain limitations were not necessary to the claim, and has deleted, in this reissue proceeding: 1) these certain limitations; and 2) related limitations that were added in the After Final Amendment filed on January 10, 1994. Applicant has previously relied on B.E. Meyers to advance his contention that patenting of broadened reissue claims is permissible under the law, under these circumstance. However, it appears that these limitations were, in fact, surrendered for reasons of patentability evidenced from the '335 file wrapper history. Accordingly, the claims are rejected. Further applicable remarks of applicant are addressed in rejection below.

1. Claims 30-32, 34-42, 44-45, 47, 49, and 51-56 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error

Art Unit: 2664

within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Considering claims 30-32, 34-42, 44-45, 47, 49, and 51-56, those limitations identified by the applicant in the declaration filed on March 19, 1998 (page 2 paragraph (6)) as being “deleted” relate to subject matter that appears to have been “surrendered” during the prosecution of the patent (e.g., the subject matter which was apparently surrendered by applicant in the after final amendment which was filed on January 12, 1994, and later entered by right when the ‘470 application was subsequently filed on April 11, 1994.) Moreover, it appears that these apparently “surrendered” limitations should be included in each of the new claims presented for reissue (claims 30-32, 34-42, 44-45, 47, 49, and 51-56).

Further considering claims to pager (e.g., claims 30-31, 35, 44, 51 and any claims depending therefrom), it appears that applicants may not be claiming the same invention as disclosed in the original patent. Although the reissue statute is remedial in nature and should be construed liberally, “not every event or circumstance that might be labeled ‘error’ is correctable by reissue.” See In re Wilder, 736 F. 2d 1566, 1516 (Fed. Cir. 1984). The test for eligibility for addition or alteration of claims in a reissue includes whether the reissue claims are for the same invention as that disclosed in the original patent. See In re Hounsfield, 699 F.2d 1320. Moreover, a nonintentional failure to obtain claims narrower in scope than the patent claims is not, as such, “error”). Hewlett-Packard Co. v. Bausch & Lomb Inc., 882 F.2d 1556.

Art Unit: 2664

Should the applicant disagree, than a detailed legal analysis providing justification for such a position is encouraged, providing case law specifically pertinent whenever possible. The applicant should also be specifically clear if and how he may be challenging Federal Circuit precedent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Luther whose telephone number is (703) 308-6609.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington D.C. 20231


or faxed to:

(703) 872-9314.

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist.)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

William Luther
Primary Examiner
June 27, 2002

A handwritten signature in black ink, appearing to read 'William Luther', is located in the bottom right corner of the page.